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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,949	01/17/2002	Carolyn Jean Cupp	112701-332	3984

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EXAMINER

HENDRICKS, KEITH D

ART UNIT 1	PAPER NUMBER
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1761

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/052,949

Applicant(s)

CUPP ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-8, 10-14, 16-21, 23-26, 28-30 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' arguments filed March 18, 2003 have been fully considered but they are not persuasive. At page 4 of the response, applicants provide traversal for the rejection, and state that "clearly, this would suggest to one skilled in the art that the addition of a humectant and an insoluble fiber in any suitable amount can be used to reduce the brittleness of the pet food." This is not deemed persuasive for the reasons of record. The question remains, over what base or standard brittleness amount, or pet food starting components, is the claimed composition "reduced"? It is unclear as to how one skilled in the art may ascertain whether a particular pet food has a "reduced" brittleness, if there is no starting pet food from which to compare. A product on its own may not be "reduced", or for that matter, "improved", "smaller", "more efficient", or any other such comparative term, without another to provide a standard comparison. Thus and again, the term "reduced" (or "reducing") is a relative term which renders the claim indefinite.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7; 14-19, 21-23, 25 and 27-28 remain rejected under 35 U.S.C. 102(b) as being anticipated by Simone et al.

Applicants' arguments filed March 18, 2003 have been fully considered but they are not persuasive.

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- At page 5 of the response, applicants state that their “invention can exhibit significantly improved cleaning of a pet’s teeth, even as compared to commercially available dried pet foods.” This is not deemed persuasive, as this would not be an unexpected property given the teachings of the reference, which also describes such results.
- At page 5 of the response, applicants state that “although Simone discloses a moisture content of 10% by weight, Applicants believe that the clear focus of Simone is to equate this moisture level to an intermediate product and not a final product contrary to the Patent Office’s position.” This is not deemed persuasive for the reasons of record. Initially, as the rejection was made under 35 U.S.C. 102(b), the fact that applicants agree that the reference discloses a moisture content of 10% by weight, only further confirms the appropriateness of the rejection. Still further, if applicants interpret this to be the moisture content of an “intermediate product and not a final product”, then the teachings of the reference state that the so-called “intermediate product”, once extruded, is *further dried*, thus reducing the moisture content even more. See, for example, the last sentence at column 5, which states that the products “are then allowed to cool and dry” to a moisture level including “about 10%.”
- Applicants state that since the instant claims recite “less than 10%”, there “is no overlap of the claimed ranges” and those of the reference. This is not deemed persuasive. Initially, it is again noted that the reference discloses moisture contents of “about 10%”, which necessarily includes amounts both above, and below, 10%. Also, while applicants’ claims recite “less than 10%”, the specification recites “less than about 10%”.
- At page 6 of the response, applicants state that the reference requires the use of corn cob fractions, and state that this would bring the total amount of fiber above the instantly-claimed ranges. Applicants further refer to the referenced examples. This is not deemed persuasive for the reasons of record. Again, Simone et al. also teach that the cellulosic fiber materials of the pet food are used in the range of about 20-50% by weight of the final product (i.e. cellulosic materials such as corn cob, etc., not necessarily cellulose levels of 20-50%). Just as applicants are not limited by their examples, neither is the reference, especially when the reference provides general teachings and guidance to one of ordinary skill in the art, that is not limited to the examples. Further, the top of column 3 of the reference states that, while preferred, corn cob fractions are *optional*. The teachings of the reference demonstrate applicants’ invention.
- At page 6 of the response, applicants state that “the clear emphasis of Simone is to provide a chew pet product that is a meal supplement and thus not an entire meal as required by the dried pet food of the claimed invention.” This is not deemed persuasive for the reasons of record. Initially, it is unclear

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from both the claims and the specification as to how applicants may describe their invention as “an entire meal”, and it is further unclear as to where this is specifically mentioned in the claims. Secondly, reference to the middle of column 5, and to lines 38-44 of column 8 of the reference, clearly state that the product was fed to the animals, similar to a commercial product, and was “chewed repeatedly before being swallowed. This chewing action increased the residence time that the chew product was in the dog’s mouth thereby increasing the contact time with the teeth”, which is the same desired effect as applicants’ claimed invention.

- At the bottom of page 6 of the response, with regard to the Office’s position that the density of the products would be an inherent property, applicants state that “mere probabilities or possibilities are not enough to establish inherency.” This is not deemed persuasive for the reasons of record. Initially, it is noted that not all claims have a limitation for product density. Secondly, applicants’ arguments do not comply with 37 CFR 1.111(c) because they do not clearly and specifically show how the amendments avoid such references or objections. Applicants themselves have set forth a “bald assertion” (pg. 6, response), without any support whatsoever. As previously stated, given the fact that the reference teachings fall within the boundaries of the instant claims, and given standard processing procedures in the art, one of ordinary skill in the art would expect the densities of the referenced product to be within the claimed ranges, absent any clear and convincing arguments and/or evidence of record. The Patent Office does not possess the facilities to test the products, and as a fact-based, reasonable rejection has been set forth, the burden shifts to applicant to demonstrate that the referenced product does not anticipate the claims.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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i) Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/037,941. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are each directed to pet food products and methods of using, with similar content, including protein, fiber, carbohydrate, water content and/or humectant.

ii) Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 and 24 of copending Application No. 09/154,646. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are each directed to pet food products and methods of using, with similar content, including protein, fiber, carbohydrate, water content and/or humectant.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

### ***Conclusion***


The Double Patenting rejection notwithstanding, claims 8-13, 20, 24 and 26 are free of the prior art of record.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
**KEITH HENDRICKS**  
**PRIMARY EXAMINER**